

REMARKS AND ELECTIONS

I. Status of the Application.

A. Restriction Requirement

In the Office Action, the Examiner alleged that two distinct inventions (the "Inventions") were being claimed in the Application and requested that the Applicant restrict the Application, pursuant to 35 U.S.C. § 121, to one of the following Inventions:

Invention I. Claims 1-43, drawn to a targeting device; and

Invention II. Claims 44-52, drawn to a method of locating the centre of the osteotomised base of the femoral neck.

B. Species Restriction Requirement

In the Office Action, the Examiner alleged that four distinct species (the "Species") were being claimed in the Application, and requested that the Applicant elect members of the species for prosecution. These species include:

Species I. Figure 1a;

Species II. Figure 1b;

Species III. Figure 1c; and

Species IV. Figure 2.

II. Provisional Election and Identification of Invention/Species.

In compliance with 37 C.F.R. § 1.143, Applicant provisionally elects Invention I for prosecution on the merits with traverse. The following is a listing of all provisionally elected claims readable on the elected Invention: 1-43. However, as explained in detail below, Applicant respectfully submits that that Examiner's restriction requirement is improper and should be withdrawn. Applicant reserves the right to file claims 44-52 in one or more divisional

applications. Further, Applicant provisionally elects Species I, which are directed towards Figure 1a and claims 1-11, 14-19, and 21-26, with traverse.

II. The Restriction Requirement Asserted in the Office Action Should Be Withdrawn.

A. The Two Inventions Contain the Same Special Technical Feature.

Applicant respectfully submits that the restriction requirement is improper and should be withdrawn because the two Inventions contain the same special technical feature. According to the PCT Rule 13.2,

[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

PCT Rule 13.2. In the Office Action, the Examiner alleged that the Inventions do not relate to a single inventive concept because they lack the same or corresponding special technical features which are novel over the prior art (Office Action, page 2). Specifically, the Examiner has identified the targeting device as the special technical feature of the pending claims, and has alleged that the targeting device is taught in PCT application publication No. WO 01/91648 to Chung et al. ("Chung"). *Id.*

In response, Applicant respectfully submits that the device of Chung does not teach the targeting device of the claimed invention. According to the Manual of Patent Examining Procedure ("MPEP"), a novelty-based prior art rejection can be overcome by showing that the prior art does not disclose all of the limitations of the claims or by amending the claims to patentably distinguish over the prior art. MPEP § 706.02(b)(8th Ed., 2010). The Chung reference does not show a device where there are a "first and second components spaced apart

from and parallel to one another where means are provided to alter the distance between the first and second components and means is provided to maintain the first and second components in a predetermined position relative to each other and wherein one or both of the first component and the second component has a portion suitable for receipt of a guide wire." Claim 1, Application. In particular, the parallel parts 17 and 18 of Chung, which have been indicated in the Office Action to be the first and second components, cannot receive a guidewire (See Figure 2 included below). Further, there are no components in Chung that meet all of the requirements for the first and second components as set forth in claim 1.

Accordingly, since the device of Chung does not teach the limitations of claim 1, the inclusion of "first and second components spaced apart from and parallel to one another where means are provided to alter the distance between the first and second components and means is provided to maintain the first and second components in a predetermined position relative to each other and wherein one or both of the first component and the second component has a portion suitable for receipt of a guide wire" in a targeting device is "a contribution which each of the claimed inventions, considered as a whole, makes over the prior art," (requirement of "special technical feature," PCT Rule 13.2) and therefore is a special technical feature. Therefore, since a special technical feature does exist for the pending claims, Applicant respectfully submits that the restriction requirement between Inventions I and II is improper and should be withdrawn.

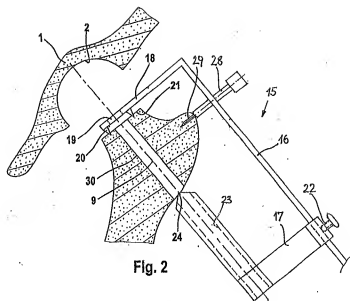


Figure 2 of Chung

B. The Species are Linked by the Same Special Technical Feature

In the Office Action, the Examiner further asserted that each of Figs. 1a, 1b, 1c, and 2 are species of generic claim 1, and that the "species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT 13.1." Office Action, page 3. In response, Applicant respectfully notes that each of Figures 1a, 1b, 1c, and 2 are directed towards a targeting device which is a general inventive concept and special technical feature (as discussed in more detail in Section IIa of this paper).

Accordingly, since claim 1 comprises a general inventive concept that is novel over Chung and has been noted in the Office Action to be generic, and that Species I-IV are each directed towards the same general inventive concept of claim 1, Applicant submits that the requirement for a Species election is improper, and should be withdrawn.

C. Serious Burden.

Even if the Examiner maintains his conclusion that the claims of Inventions I and II are independent and distinct, Applicant respectfully submits that the restriction requirement should still be withdrawn because the examination of all of the claims can be made without a serious burden. To establish a proper restriction requirement, the Examiner must not only provide support as to why the alleged inventions are independent or distinct, but also provide reasons as to why a "serious burden" would be placed on the Examiner if restriction is not required. 37 C.F.R. § 1.141(a); M.P.E.P. §§ 803, 808. "If the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions." MPEP § 803 (emphasis added). In this instance, Applicant submits that the Examiner has not put forth a reason why a serious burden would be placed on the Examiner, as required in MPEP § 803). Given that the same special technical feature is present in both Inventions, Applicant respectfully submits that a search and examination of the current claims can be performed without a serious burden.

Accordingly, for all of the foregoing reasons, Applicant respectfully submits that the present restriction in the Office Action is improper and should be withdrawn. In the event that the Examiner maintains the restriction requirement despite the forgoing amendments and arguments, Applicant notes that this restriction requirement has the effect of an admission on behalf of the Patent Office that the Invention II claims are patentable over the disclosure of the invention of Invention I. This position is necessary for entry of the restriction requirement by the Patent Office and may be relied upon by Applicant during examination of this and any divisional or continuation application. MPEP §§ 802.01; 802.02; 803; 803.01; 806; 806.04(h); 806.05(f). Applicant reserves the right to file a divisional patent application for claims 44-52 in the event that the restriction requirement is not withdrawn.

CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that Applicant has made a patentable contribution to the art. In the event that Applicant has inadvertently overlooked the need for payment of any additional fees or extensions of time, Applicant conditionally petition therefore, and authorizes any deficiency or overpayment, to be charged to deposit account 09-0007. When doing so, please reference docket number P01466-US-00 (13030.0010).

Respectfully submitted,

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